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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS MN 55402

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OFFICE OF PETITIONS

In re Application of :
Katagiri et al. : DECISION GRANTING
Application No. 09/887,272 : PETITION
Filed: 23 June, 2001 :
Att'y Dkt No. 1360.003US2 : :

This is a decision on the communication filed on 20 September, 2001, styled "Request to Correct U.S. Patent and Trademark Office Error" which is treated as a petition under 37 CFR 1.10(c) requesting that the above-identified application be accorded a filing date of 23 June, 2001, rather than the presently accorded filing date of 22 June, 2001.

This is also a decision on the petition under 37 CFR 1.78(a)(3), filed on 21 November, 2001, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of prior-filed nonprovisional Application No. 09/887,271, filed on 22 June, 2001.

The Office apologizes for the delay in responding to the present petitions.

The petition under 37 CFR 1.10(c) is **granted**.

The petition under 37 CFR 1.78(a)(3) is **dismissed as moot**.

Petition Under 37 CFR 1.10(c)

Petitioners assert that an application was filed on 22 June, 2001, under Express Mail No. EL721275472US and Docket No. 1360.003US1, and that another application with the same invention title and first named inventor was filed on 23 June, 2001, under Express Mail No. EL671641675US and Docket No. 1360.003US2.

Petitioners further assert that the Office erroneously stamped the return receipt postcards for both applications with the above-identified application number and filing date, and request that the latter application (Docket No. 1360.003US2) be assigned a new application number and accorded a filing date of 23 June, 2001.

A review of Office PALM records reveals that the application filed under Docket No. 1360.003US1 has been assigned Application No. 09/887,271, and accorded a filing date of 22 June, 2001, while the application filed under Docket No. 1360.003US2 has been assigned Application No. 09/887,272 and accorded a filing date of 22 June, 2001. Thus, each application has already been assigned a separate Application Number.

Furthermore, a review of the papers located in the official file of Application No. 09/887,272 reveals that an itemized transmittal sheet bearing Express Mail No. EL671641675US was filed with the original application papers. Although a copy of the Express Mail label is not located among the papers filed with the present petition on 20 September, 2001, a search of the USPTO's USPS Express Mail Information Database reveals that this Express Mail Label No. was accepted by the USPS on 23 June, 2001.

In view of the above, the petition is granted to the extent that the filing date of Application No. 09/887,272 is corrected to 23 June, 2001. No petition fee is required and none has been charged.

Petition Under 37 CFR 1.78(a)(3)

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after 29 November, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) of the prior-filed application, unless previously submitted;¹

¹Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The present pending application was filed on 23 June, 2001, and was copending with the above-noted, prior-filed nonprovisional application, at the time of filing, for which priority is claimed. A reference to the above-noted, prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, which was filed concurrently with the present petition under 37 CFR 1.78(a)(3).

The present nonprovisional application was filed after 29 November, 2000. Also, the reference to the prior-filed nonprovisional was submitted during the pendency of the nonprovisional application for which the benefit is sought.² However, since the claim for priority herein is submitted within the period specified in 37 CFR 1.78(a)(2), no petition under 37 CFR 1.78(a)(3) is necessary.³

In filing the preliminary amendment accompanying the petition filed on 21 November, 2001, it appears that petitioner is canceling all earlier claims to priority. Petitioner is reminded that if earlier benefit claims are cancelled, petitioner may not later re-assert the claims to benefit being cancelled, because the delay in asserting the claims would not be unintentional.

specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate. (see § 1.14).

²See 35 U.S.C. § 120.

³The petition and amendment claiming the benefit under 35 U.S.C. § 120 to Application No. 09/887,271, filed on 22 June, 2001, was filed on 21 November, 2001, which is within 16 months of the filing date of the application for which a claim for benefit under 37 CFR 1.78(a)(2) is made (Application No. 09/881,271).

The application is being returned to the Office of Initial Patent Examination (OIPE) for correction of the filing date to 23 June, 2001, for correction of the priority information, and for issuance of a corrected Filing Receipt.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (703) 308-6918.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions